



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Group Art Unit: 1714

Serial No.: 09/398,377

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Box AF

Assistant Commissioner for Patents

Washington, DC 20231

REPLY

Sir,

This paper is filed in response to the Office Action mailed Dec. 21, 2000, which is a Final Rejection. Reconsideration, reexamination and allowance are respectfully requested in view of the Amendments and Remarks below.

REQUEST TO RECONSIDER THE FINALITY OF THE REJECTION

The Examiner is asked to reconsider the finality of the rejection and to treat this Reply as including a Petition to withdraw the finality of the rejection.

One of the grounds of rejection in the previous Office Action, mailed April 20, 2000, was a rejection of claims 1 and 2 under 35 U.S.C. 102/103 over a document which was designated (on page 4 of the Office Action) as "Kao Corp JP-4-100534 A".

CERTIFICATE OF MAILING UNDER 37 CFR 1.8

I hereby certify that this correspondence is being deposited with United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231  
On March 12, 2001

Typed name of person signing this certificate: T.H.P. Richardson  
Signature

6

The Office Action was accompanied by Japanese language version of JP-4-100534 A and by a 13-line English language abstract of JP-4-100534 A. The rejection refers only to the English language abstract. As noted in the Reply mailed Aug. 21, 2000, all the claims were restricted to the use of a side chain crystalline (SCC) polymer as the oil thickener, and the abstract of Kao Corp JP-4-100534 A does not suggest the possibility of using an SCC polymer of any kind. Nor does the Office Action mailed Dec. 21, 2000, contain any indication that JP-4-100534 A discloses an SCC polymer.

In a telephone conversation with the Examiner before the Reply was mailed on Aug. 21, 2000, the undersigned told the Examiner that he was not aware of any translation of the Japanese language document and that he was unable to understand the Japanese language document. The Examiner indicated that he would attempt to obtain a translation of the Japanese text.

The Office Action mailed Dec. 21, 2000, was accompanied by a full translation of the Japanese language document, and made a final rejection which is, as a matter of words, the same as the rejection made in the previous Office Action. However, as a matter of fact, the rejection is a new rejection since it is not based on the English language abstract previously supplied, but rather on the full translation of the Japanese language document supplied with the final rejection. The translation, unlike the abstract, makes it clear that the oil thickener may be a particular type of SCC polymer.

Applicants are grateful to the Examiner for supplying the full translation, since it is in everybody's interests that all relevant documents should be considered during prosecution. However, it is submitted that the rejection in the Office Action mailed Dec. 21, 2000, is in effect a new rejection and should not, therefore, have been made final.